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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,271	07/30/2003	Akira Suzuki	106-54 DIV	8712
23869	7590	05/02/2006		
HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			EXAMINER MARINI, MATTHEW G	
			ART UNIT	PAPER NUMBER

2854

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/630,271	<b>Applicant(s)</b> SUZUKI, AKIRA	
	<b>Examiner</b> Matthew G. Marini	<b>Art Unit</b> 2854	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/03/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 12/12/2001. It is noted, however, that applicant has not filed a certified copy of the JP 2001-378439 application as required by 35 U.S.C. 119(b).

### ***Specification***

The disclosure is objected to because of the following informalities:

In the Specification, page 3, line 8, it appears that the word "hart" should read --hard--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arai (5,904,091) in view of Henbo (5,871,833).

As to Claim 4, Arai teaches Fig. 1 a method of engraving an engraving sheet, 10, with an engraving device, seen in Fig. 2, in accordance with a picture signal, Col. 1 lines 57-60, with the engraving sheet, 10, formed of a support layer, of a synthetic resin 11, and an engraving layer, 12, arranged on the support layer, 11, with the engraving layer, 12, to be engraved down to the support layer, 11; generating a picture signal, Col. 1

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lines 57-60 in which a color signal of the engraving layer becomes relatively lower in level when an original picture is picked up with an image pickup device, Col. 2 line 51-55, and producing an engraved picture to present a positive image under the presence of reflected light rays and a negative image under the presence of transmitted light rays entering from behind by allowing the engraving device to engrave the engraving sheet down to the support layer in response to the picture signal depending on the magnitude of the picture signal, Col. 2 lines 63-67. Arai fails to teach the support layer being fabricated of bi-axially oriented high-density polypropylene, the engraving layer has an opacity of 40% or more, and the support layer is lower in opacity than the engraving layer with a difference of 20% or more between the opacity of the support layer and the opacity of the engraving layer.

Henbo teaches in Production Example 2, Col. 7 lines 17-23, a support layer primarily made from polypropylene, where in Table 1, under production example 2, the engraving layer has an opacity of 93%, (greater than 40%) and the support layer has an opacity of 62% (lower than the engraving layer), making the difference between the two 31% (greater than 20%). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the polypropylene material of Henbo as the support layer of Arai because in Henbo Col. 1 lines 55-67 this material eliminates problems of the images peeling off or rumbleing, also this type of material can be easily fed for printing and discharged, Col. 2 lines 39-44.

As to Claim 5, Arai teaches in Col. 2, lines 51-55 where the original picture is a photograph of the face of an individual except the engraving layer being whitened.

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Henbo teaches in Col. 5 line 27-28 ground calcium carbonate being part of the mixture for the engraving layer, which in one of the applicant's examples sited in the specification on page 9 line 13. It would have been obvious to one of ordinary skill in the art at the time of the invention to use ground calcium carbonate as part of the engraving layer because in Col. 5 lines 25-37, the fine inorganic powders, also referred to as pigments indicating they add color, provide abrasion resistance, helping to make a more durable and resilient product.

Claims 6 and 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Arai (5,904,091) in view of Henbo (5,871,833), and further in view of Suzuki (5,298,307).

As to Claims 6 and 7, Arai and Henbo teach all that is claimed in the above rejection of Claim 4 and 5, except producing an engraved picture to present a negative image under the presence of reflected light rays and a positive image under the presence of transmitted light rays entering from behind by allowing the engraving device to engrave the engraving sheet down to the support layer in response to the picture signal depending on the magnitude of the picture signal.

Suzuki teaches in Col. 4 lines 65-68 the engraved images can be clearly seen, positive image, when the light is transmitted through the engraving sheet structure. In Col. 5 lines 33-36, the image is not clearly seen with reflected light, therefore a negative image. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify Arai to have the image been seen clear with transmitted light and not to be seen clearly with reflected light, because in Suzuki Col. 5 lines 33-36 this

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element prevents forgery, ensuring making it hard to photocopy to tamper with that image/document.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew G. Marini whose telephone number is (571)-272-2676. The examiner can normally be reached on Monday-Friday 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571)-272-2168. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew Marini

  
4/20/06



**REN YAN  
PRIMARY EXAMINER**